

REMARKS

Applicants respectfully request reconsideration of the subject application in view of the amendments and remarks set forth herein. Applicants note with appreciation that the Examiner has withdrawn the rejections of the claims based on 35 USC §103. Reconsideration of the application is respectfully requested.

1. Status of the Claims

Claims 1, 2, 4-8, 10-11 and 14-28 have been rejected. Claim 29 has been withdrawn. Claims 1, 11 and 26 are amended herein. No new matter is added by these amendments. After entry of the foregoing amendments, claims 1-2, 4-8, 10-11 and 14-28 are pending in this application.

2. Claim Amendments

Applicants respectfully submit that no new matter is introduced by way of the foregoing claim amendments. Independent claim 1 has been amended to more clearly recite the subject matter associated with the present disclosure. Support for the amendments to claim 1 can be found in the specification, as originally filed, particularly with reference to paragraphs 82-84, 146-148 and Figure 2 and the associated text.

In view of the foregoing amendments to independent claim 1, applicants have amended dependent claims 11 and 26 to conform the dependencies thereof.

As amended, claims 1-2, 4-8, 10-11 and 14-28 are pending in the present application. Applicants respectfully submit that no new matter is introduced by way of applicants' proposed claim amendments, and prompt entry thereof is respectfully requested.

3. §112 Rejections

The outstanding Office Action sets forth a rejection under 35 USC §112, as follows:

Claims 1-2, 4-8, 10-11 and 14-28 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventors, at the time the application was filed, had possession of the claimed invention. More particularly and in regards to independent claim 1, the Examiner contends that: (i) there is not any support for using specifically a non-vibrating high pressure vessel; and (ii) the specification does not show support in using nanoparticles or submicron particles having a particle size of less than about 500 nm.

Applicants respectfully traverse the §112 rejections and submit that the above claims satisfy the written description requirement of 35 U.S.C. §112. Reconsideration of the foregoing §112 rejections in view of the amendments and remarks set forth herein is respectfully requested.

Independent claim 1 has been amended to more clearly recite the subject matter of the present disclosure. In particular, applicants have amended independent claim 1 to more clearly recite that “no vibrational force is applied to the high pressure vessel while the antisolvent and suspension are combined in the high pressure vessel.” Claim 1, as amended, overcomes the Examiner’s rejection under § 112. Applicants respectfully submit that independent claim 1, as amended, satisfies the written description requirement of 35 U.S.C. §112 because all of the subject matter contained in independent claim 1, as amended, was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Moreover, applicants respectfully disagree with the Examiner that the specification does not show support in using nanoparticles or submicron particles having a particle size of less than about 500 nm. The specification, as originally filed, describes using nanoparticles or submicron particles having a particle size of less than about 500 nm at least in the following:

- (i) Paragraph 80 (e.g., “20 nm” and “16 nm” particles as listed in the Table contained in paragraph 80);
- (ii) Paragraph 84, lines 6 and 9, and the Table contained in paragraph 84 (e.g., “16-20 nm silica”);

(iii) Paragraph 85, line 3-4 (e.g., "since the primary particles are less than 100 nm");

(iv) Paragraph 93, lines 8-9 (e.g., "the primary particle size can be estimated to be in the range of about 16-30 nm);

(v) Paragraph 94, lines 6-8 (e.g., "the primary particle size of coated hydrophobic silica nanoparticles appears to have increased to about 50-100 nm");

(vi) Paragraph 110, lines 3-7 (e.g., "it is noted that nanoparticle coating or encapsulation with a polymer using the SC CO₂ SAS coating process was investigated to reveal that 16-20 nm nanoparticles may be successfully coated or encapsulated in polymer by the SAS coating process.");

(vii) Paragraph 142, lines 1-4 (e.g., "The exemplary host particles that were used in this additional SAS coating study were spherical silica particles with size of approximately 0.5 μ m [500 nm] which were synthesized using the classic Stober process");

(viii) Paragraph 168, lines 6-8 and Figure 32 (e.g., "As shown in FIG. 32, the average particle size of uncoated silica particles is 0.556 micron with a standard deviation of 0.1 micron."); and

(ix) Paragraph 175, lines 1-4 (e.g., "It is readily apparent that agglomeration among the coated particles occurred because the average size of the uncoated particles is 0.556 microns with a narrow size distribution of 0.1 micron.").

For at least the foregoing reasons, the specification, as originally filed, describes using nanoparticles or submicron particles having a particle size of less than about 500 nm. Thus, all of the subject matter contained in independent claim 1, as amended, was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

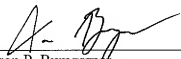
For at least the foregoing reasons, applicants respectfully submit that independent claim 1 satisfies the written description requirement of 35 U.S.C. §112. In addition, applicants respectfully submit that claims 2, 4-8, 10-11 and 14-28, which depend directly or indirectly from independent claim 1, satisfy the written description requirement of 35 U.S.C. §112 for at least the reasons noted with respect to independent claim 1. Reconsideration and withdrawal of the §112 rejections is respectfully requested.

CONCLUSION

Accordingly, for at least the stated reasons, claims 1-2, 4-8, 10-11 and 14-28 all satisfy the written description requirement of 35 U.S.C. §112. Reconsideration and prompt allowance of all pending claims is respectfully requested. If the examiner believes that a telephone conversation may be useful in advancing prosecution of the application, the examiner is invited to contact applicants' undersigned counsel.

Respectfully submitted,

Date: August 20, 2008



Aaron P. Bumgarner
Reg. No. 53,860
Attorney for Applicants

McCARTER & ENGLISH, LLP
Financial Centre, Suite A304
695 East Main Street
Stamford, CT 06901
(203) 399-5946
(203) 399-5846 (fax)